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transmission means for transmitting facsimile data via the Internet; and  
notification means for notifying a recipient, by a method different from that of the  
transmission means, that the transmission means has executed transmission of the facsimile data  
via the Internet.

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22. (Twice Amended) A communication apparatus comprising:  
first means for sending facsimile data over a first communication network to a recipient;  
second means for sending data over a second communication network to said recipient;  
third means for controlling the first means and the second means;  
wherein the third means controls the second means so as to send data corresponding to  
the sending operation of the first means, and  
wherein the sending operation of the second means indicates that the first means has  
executed transmission of the facsimile data over the first communication network to said  
recipient.

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#### REMARKS

The above Amendment and following remarks are responsive to the points raised in  
the Office Action dated August 1, 2001.

Upon entry of this Amendment, Claims 1-25 are all the claims pending in the  
application. Claims 1-3, 5-6, 8-11, 20 and 22 will have been amended. The attachment to this  
Amendment shows the amendments made to claims 11-3, 5-6, 8-11, 20 and 22 by bracketing

the text that has been deleted and underlining the text that has been added. No new matter has been introduced by this Amendment. Entry and consideration of this Amendment are respectfully requested. The Applicant respectfully requests entry of this Amendment, favorable reconsideration of this case, and early issuance of a Notice of Allowance.

A Petition for a three-month extension of time and Notice of Appeal accompany this Amendment.

**Response To The Rejection Under 35 U.S.C. §102**

In the Office Action, claims 1 and 9 are rejected under 35 U. S. C. §102(e) as being anticipated by both of Gordon (U.S. Patent No. 5,608,786, hereafter Gordon) and Ho et al. (U.S. Patent No. 5,805,298, hereafter Ho). Claims 20, 22 and 25 are rejected under 35 U. S. C. §102(e) as being anticipated by Foladare et al. (U.S. Patent No. 5,905,777, hereafter Foladare). Claims 20-24 are rejected under 35 U. S. C. §102(e) as being anticipated by Williams et al. (U.S. Patent No. 6,192,045, hereafter Williams).

**Claims 1 and 9**

The present invention, as recited in claims 1 and 9 as amended, is directed to a communication apparatus and method that comprises a communication means for notifying a recipient using a PSTN that a facsimile is being sent through the Internet, wherein the notification is prior to the recipient accessing the Internet. This is a feature not believed to be disclosed in either Gordon or Ho.

Gordon discloses a method and system that makes voice mail, facsimile mail and e-mail conveniently accessible to receive as well as to transmit. (col. 1, lines 7-10). Specifically, in Gordon, a subscriber sends data (i.e. fax) to a UniPost Access Node 6. The UniPost Access Node 6 is connected to other UniPost Access Nodes 6 in the system for exchanging of data. A subscriber can access a UniPost Access Node 6 in the system to both send and receive data. (col. 7, lines 18-66). However, in Gordon, the only way a subscriber knows the data was received is to access a node 6. In other words, the subscriber must be connected to the Internet prior to receiving a facsimile message.

Ho is directed to a communication device that transmits and receives information in accordance with both facsimile and electronic mail communication protocols. Specifically, a user wishing to receive e-mail from a remote mailbox presses a start button, enters a destination identifier 402 via keyboard 206 to identify the remote mailbox and presses an e-mail key on the keyboard. The communications device responds at destination identifier 402 by reading the destination identified and attempting to connect to a predetermined Internet access provider, which implements the router 107 of FIG. 1, to establish a SLIP/PPP type connection. The communications device 416 obtains, in accordance with the POP3 Transfer Protocol, from the remote mailbox, data indicative of the e-mail box and displays such data on the display. (col. 7, line 63 through col. 8, line 24). Thus, as in Gordon, the system in Ho also requires that the communication device be connected to the Internet prior to receiving any type of notification of a facsimile or other type of data communication. (col. 7, line 63 through col. 8, line 24).

Conversely, in the present invention, the communication apparatus can send a notification to another user prior to that user being connected to the Internet. Specifically, when a facsimile is sent via the Internet, the control circuit 20 of the facsimile apparatus notifies the apparatus location and another station (i.e. station B) using the PSTN that a fax is being sent through the Internet. After such notification, the user then can be connected to the Internet to receive the facsimile communication.

Therefore, claims 1 and 9 are now believed to be distinguishable over Gordon and Ho. Likewise, claim 3 is also believed to be distinguishable over Gordon and Ho based on its dependency from claim 1.

**Claims 20, 22 and 25**

The present invention, as recited in claims 20 and 22 as amended, is directed to a communication apparatus comprising a means for transmitting facsimile data via the Internet and a notification means for notifying a recipient that the transmission means has executed the transmission of facsimile data via Internet, which is a features not believed to be disclosed in Faladare.

Faladare discloses an electronic mail paging system that transmits e-mail messages over an e-mail network to a server that is servicing a recipient. (see Abstract). Specifically, in Faladare, an e-mail can be forwarded by the server 60 over computer network, such as a public telephone network 64, to a selected computer 70 or 70' or to a selected fax machine 72 or 72' at the recipient office, home or other destination. (col. 4, lines 49-54). Although, the communication apparatus disclosed in Faladare sends an e-mail message to a facsimile device

via the PSTN, it fails to disclose a communication apparatus that transmits facsimile data via the Internet as a result of the e-mail message, and as specifically recited in claims 20 and 22.

Therefore, claims 20 and 22 are now believed to be distinguishable over Faladare. Likewise, claims 21, 23, 24 and 25 are also believed to be distinguishable over Faladare based on their dependency from claims 20 and 22.

**Claims 20-24**

The present invention, as recited in claims 20 and 22 as amended, is directed to a communication apparatus that includes a notification means for notifying a recipient that a facsimile has been executed over the Internet to the recipient, which is a feature not believed to be disclosed in Williams.

Williams discloses a method of dynamically connecting an originating computer to a receiving computer on a dial-up network, such as the Internet. Specifically, a sending fax machine 51 initiates the sending of a fax, and the attached fax call-back device 53 detects a special code and intercepts the call. Next, the fax call-back device 53 establishes a connection 61 to local exchange carrier (LEC) 55 by going off-hook. It then transmits signaling tones received from sending fax machine 51 to LEC 56 corresponding to the phone number of receiving fax machine 52. LEC 55 establishes a connection 63 via a long distance carrier 59 (LDC) to the LEC 56 located near the receiving fax machine 52. LEC 56 signals fax callback device 54 attached to receiving fax machine 52 of the incoming phone call by generating a ringing signal. Fax call-back device 54 answers the incoming call 62 and waits to see if incoming phone call 62 is immediately terminated. If incoming phone call 62 from LEC 56 is immediately terminated,

fax call-back device 54 establishes a connection 62 to LEC 56 by going off-hook. It then transmits signaling tones to LEC 56 corresponding to a preprogrammed phone number associated with the immediately terminated call, and connects to the fax call-back device's 54 Internet Service Provider (ISP) 58. LEC 56 then establishes a connection 66 to Internet 60 via ISP 58 to send the facsimile. (Col. 8, line 46-Col. 9, line 18).

Therefore, although Williams discloses a means for sending a facsimile communication using the Internet, it fails to disclose a notification means that notifies a recipient that a communication device has already executed transmission of facsimile data via the Internet. Instead, in Williams, the communication device is preprogrammed to detect if the incoming call 62 from LEC 56 is immediately terminated, and then establishes an Internet connection so that the sending facsimile machine 51 can execute transmission of facsimile data.

Thus, claims 20 and 22 are believed to be distinguishable over Williams. Additionally, claims 21, 23, 24 and 25 are also believed to be distinguishable over Williams based upon their dependency from claims 20 and 22.

#### **Response To The Rejection Under 35 U.S.C. §103**

Claims 1, 2 and 4-11 are rejected under 35 U. S. C. §103(a) as being unpatentable over Cooper et al. (U.S. Patent No. 6,052,442, hereafter Cooper) in view of Kulakowski (WIPO Publication No. WO97/10668, hereafter Kulakowski). Claims 12, 13, 18 and 19 are rejected under 35 U. S. C. §103(a) as being unpatentable over Mordowitz et al. (U.S. Patent No. 6,011,794, hereafter Mordowitz) in view of Bloomfield (U.S. Patent No. 6,025,931, hereafter

Bloomfield). Finally, claims 14-16 are rejected under 35 U. S. C. §103(a) as being unpatentable over Mordowitz in view of Bloomfield, and further in view of Bobo, II (U.S. Patent No. 5,657,507, hereafter Bobo).

**Claims 1, 2 and 4-11**

The present invention, as recited in claims 1, 2, 5 and 9-11, is directed to a communication method, and apparatus and a control method that transmits facsimile data to a recipient over the Internet, but first gives or receives an indication regarding the facsimile being sent. The indication is sent or received using the PSTN. The indication includes, for example, a notification or displayed information regarding the executed facsimile by a sender prior to setting up connection to the Internet to receive the facsimile. This is a feature not believed to be taught or suggested by Cooper in view of Kulakowski.

Cooper teaches an integrated answering machine system that checks for electronic mail message by calling a service provider and downloading the message. However, as noted by the Examiner (page 11), Cooper fails to teach notifying a recipient using a PSTN. Moreover, Kulakowski is directed to a device and method for transmitting or receiving a facsimile via a computer network to which the device connected. Specifically, the device establishes a telephone connection via the PSTN with a computer on the network, such as that of an on-line service provider. The device converts the facsimile or voice data to be transmitted into a suitable e-mail format. The device transmits the e-mail message to a service provider and the service provider routes the e-mail message to a recipient. (page 5, line 30-page 6, line 6). Thus, in Kulakowski, there is no notification using the PSTN that facsimile is being sent via the Internet.

In fact, Kulakowski states that data is sent via the Internet to the recipient without any prior notification.

Conversely, in the present invention, a recipient receives an indication of that a facsimile is being sent using the PSTN. The recipient then establishes a connection to the Internet to receive the facsimile communication. In other words, the indication of the transmission of the facsimile is completed using two different channels of communication i.e., the indication is completed using the PSTN, while the facsimile is executed and received using the Internet. Moreover, the indication of the sent fax is completed prior to the recipient having to access the Internet.

Therefore, even if one of the ordinary skilled in the art were to combine the teachings of Cooper and Kulakowski, the combination still would not possess all limitations recited in claims 1, 2, 5 and 9-11. Thus, claims 1, 2, 5 and 9-11 are believed to be distinguishable over Cooper in view of Kulakowski. Likewise, claims 3, 4, and 6-8 are also believed to be distinguishable over Cooper in view of Kulakowski based upon their dependency from claims 1, 2 and 5.

**Claims 12, 13, 18 and 19**

The present invention, as recited in claims 12, 13, 18 and 19, is directed to a communication apparatus, method and a computer-readable storage medium for a communication apparatus that includes a notification means for calling a recipient over the PSTN to notify the receipt that a facsimile is being sent through the Internet, which is a feature not believed to be taught or suggested by Mordowitz in view of Bloomfield.



Mordowitz is directed to an Internet related accessory that enables a party to establish a long distance telephone connection to the Internet. (see Abstract). In Mordowitz, a telephone call between parties can be connected over a conventional calling line 12, 13 or over the Internet via the Internet service provider 11. However, nowhere does Mordowitz disclose notifying a calling party via the PSTN when a dial connection to the Internet is established, let alone notification related facsimile communication being sent over Internet.

Bloomfield is directed to a facsimile-to-e-mail system whereby facsimile communication is sent to a recipient via the Internet. (see Abstract). Specifically, the system bridges two networks by interacting first with the PSTN to transmit telephony signals (a facsimile message to a FEM-GATEWAY); and second interacting with an e-mail network (through the internet) to deliver the e-mail message to the intended recipient. (col. 2, lines 46-55). In other words, the connection to the PSTN, in Bloomfield, is required for connecting the Internet and sending a facsimile communication. However, the connection to the PSTN is not for any type of notification function, let alone notification related to a facsimile communication over the Internet.

Therefore, even if one of the ordinary skilled in the art were to combine the teachings of Mordowitz and Bloomfield, the combination still would not possess all the limitations recited in claims 12, 18, and 19. Thus, claims 12, 18 and 19 are believed to be distinguishable over Mordowitz and Bloomfield. Likewise, claims 13-17 are also believed to be distinguishable of Mordowitz in view of Bloomfield based upon their dependency from claims 12.

**Claims 14-16**

As mentioned previously, Mordowitz and Bloomfield fail to disclose notifying a recipient via the PSTN that a dial-up connection to the Internet is being established to transmit a facsimile communication, as recited in claim 12, and from which claims 14-16 depend.

Moreover, Bobo is directed to a Message Storage and Deliver System (MSDS) that is connected to telephone lines and receives facsimile message. (see Abstract). Specifically, a telephone is directed to a number serviced by the MSDS 10 and connected to a third party 24. In other words, a call is routed over the DID trunk 15 to the MSDS 10. The MSDS then routes the call to a third party via the Internet. (Col. 6, line 61 through Col. 7, line 11).

Thus, as in Mordowitz and Bloomfield, Bobo uses the PSTN to connect to an ISP provider for sending the facsimile data to a recipient. However, nowhere does not Bobo teach or suggest notifying a recipient using the PSTN regarding the execution of facsimile communication.

Therefore, even if one of the ordinary skilled in the art were to combine the teachings of Mordowitz, Bloomfield and Bobo, the combination still would not include all the limitations as recited in claims 12, from which claims 14-16 depend. Thus, claims 14-16 are believed to be allowable over Mordowitz and Bloomfield and further in view of Bobo.

### **CONCLUSION**

In view of the above Amendment and remarks, the Applicants respectfully submit that all the pending claims are patentable over the prior art of record and are now in condition for allowance. Accordingly, the Applicant respectfully requests favorable reconsideration of this

case and early issuance of a Notice of Allowance.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, including any extension of time, or credit any overpayment to Deposit Account No. 13-4503, Order No. 1232-4467.

Respectfully submitted,

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Takehiro YOSHIDA

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**ATTACHMENT**

**BOX AF**

Commissioner of Patents  
Washington, D.C. 20231

SIR,

Please note the following amendments to claims 1-3, 5-6, 8-11, 20, and 22:

**IN THE CLAIMS**

1. (Amended) A communication apparatus comprising:

facsimile communication means for performing facsimile communication through the Internet by dial-up connection [with a station]; and

notification means for notifying a recipient [the station] using a PSTN that [the] a facsimile [communication] is being sent through the Internet, [has been executed] prior to the recipient accessing the Internet.

2. (Twice Amended) A communication apparatus comprising:

facsimile communication means for performing facsimile communication through the

Internet by dial-up connection; and

reception means for, in response to a notification, from [when it is notified by] a calling party communication apparatus using a PSTN, that the calling party communication apparatus is sending a facsimile to the communication apparatus [communication] through the Internet [has been executed by dial-up connection], setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by POP.

3. (Amended) The apparatus according to claim 1, further comprising selection means for selecting on the basis of a user operation whether the communication is an important communication, and wherein

when the important communication is not selected said notification means do not notify [the station] using a PSTN that the facsimile is being sent [communication] through the Internet [has been executed].

5. (Twice Amended) A communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

display means for, in response to a notification, from [when it is notified by] a calling party communication apparatus using a PSTN, that the calling party communication apparatus is sending a facsimile to the communication apparatus [communication] through the Internet [has been executed], displaying information representing that the calling party communication apparatus is sending a facsimile to the communication apparatus [communication] through the

Internet [has been executed] and station address information of a calling party; and

determination means for determining on the basis of selection by a user whether [said] the communication apparatus is to set up connection to the Internet by dial-up connection to receive facsimile communication information through the Internet by POP.

6. (Amended) The apparatus according to claim 5, further comprising operation mode registration means for registering whether, in response to the notification [when it is notified using the PSTN that communication through the Internet has been executed], dial-up connection is to be immediately performed on the basis of a station address of the calling party communication apparatus to receive the facsimile communication information through the Internet by POP.

8. (Amended) The apparatus according to claim 5, further comprising display means for, in response to the notification [when it is notified using the PSTN that communication through the Internet has been executed], displaying a list of communication management information independently of communication management information associated with normal transmission/reception[;]and

[display means for] displaying[, in correspondence with the notification,] whether reception of the facsimile communication information from the service provider is complete.

9. (Amended) A communication method comprising:

a facsimile communication step of performing facsimile communication through the Internet by dial-up connection [with a station]; and

a notification step of notifying a recipient [the station] using a PSTN that a [the] facsimile is being sent [communication] through the Internet [has been executed] prior to the recipient accessing the Internet.

10. (Twice Amended) A control method for a communication apparatus comprising:  
a facsimile communication step of performing facsimile communication through the Internet by dial-up connection with a station; and

a reception step of, in response to a notification, from [when it is notified by] a calling party communication apparatus using a PSTN, that the calling party communication apparatus is sending a facsimile to the communication apparatus [communication] through the Internet [has been executed by dial-up connection], setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by POP.

11. (Twice Amended) A control method for a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising the steps of:

in response to a notification, from [when it is notified by] a calling party communication apparatus using a PSTN, that the calling party communication apparatus is sending a facsimile to the communication apparatus [communication] through the Internet [has been executed], displaying information representing that the calling party communication apparatus is sending a

facsimile to the communication apparatus [communication] through the Internet [has been

executed] and station address information of the calling party communication apparatus; and

determining on the basis of selection by user whether [said] the communication apparatus is to set up connection to the Internet by dial-up connection to receive facsimile communication information through the Internet by POP.

20. (Twice Amended) A communication apparatus comprising:

transmission means for transmitting facsimile data via the Internet; and

notification means for notifying a recipient, by a method different from that of the transmission means, that the transmission means has executed transmission [is prepared to transmit] of the facsimile data via the Internet.

22. (Twice Amended) A communication apparatus comprising:

first means for sending facsimile data over a first communication network to a recipient;

second means for sending data over a second communication network to said recipient;

third means for controlling the first means and the second means;

wherein the third means controls the second means so as to send data corresponding to the sending operation of the first means, and

wherein the sending operation of the second means indicates that the first means has executed transmission of the [is prepared to send] facsimile data over the first communication network to said recipient.